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EXAMINER

DINH, KHANH Q

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/633,899  
Filing Date: August 07, 2000  
Appellant(s): GRESS ET AL.

**MAILED**

**JAN 25 2008**

**Technology Center 2100**

Edwards J. Stemberger (Reg. No.36,017)  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 11/29/2007, 11/15/2007 and 10/9/2007  
appealing from the Office action mailed April 4, 2007.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The amendment after final rejection filed on June 4, 2007 has not been entered.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

20030147518 A1	ALBAL	8-2003
6,243,376	NG ET AL	06-2001
5,870,549	BOBO II	02-1999

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter (the term "non generic voice message" in independent claims 1, 12, 18 and 29) which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of 35 U.S.C. 102(e) which forms the basis for all obviousness rejections set forth in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1, 2, 5, 9-13, 15, 18-19, 22, 26, 26- 29, 31 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Albal et al. (hereafter Albal), US 2003/0147518 A1.

As to claim 1, Albal discloses a method in an application server for playing a messaging prompt of a called party (subscriber) to a calling party, the method comprising:

- receiving calling party number information specifying a calling party (see abstract, fig.2, [0022] to [0023]);

- accessing stored calling party number information from an Internet Protocol (IP) based database server (using Communication node 56 fig.2 and a server for serving caller's requests including IP requests) configured for storing calling party number information (see [0025] to [0028] and [0077] to [0080]);

- comparing the received calling party number information to the stored calling party number information to determine if there is a match between the received calling party information number and the stored calling party number information (verifying the caller's number, see fig.4, [0029] to [0030]);

- based on a determined match of the stored calling party number information identifying the calling party as a matched calling party (finding a match between the caller's telephone number and a stored number in the subscriber's contact list, see

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[0025] to [0026]), retrieving a personalized, non generic voice message having a recorded voice of the called party (subscriber) (the subscriber can instruct the communication node to play a pre-record message or announcement or disconnect the call or indicating to the caller that the subscriber is unavailable, see [0031] to [0033]), corresponding to the matched, stored calling party number information, for playback the message prompt to the calling party (automatically identifying the user and providing a personal greetings to the user, see [0040] and [0046] to [0050]).

As to claim 2, Albal discloses the received and stored calling party number information each includes at least a portion of a telephone number of the calling party (see [0036] to [0040] and [0074]).

As to claim 5, Albal discloses retrieving the stored personalized voice message from the IP based database server (see [0077] to [0081]).

As to claims 9 and 10, Albal discloses corresponding a flag to certain of the stored calling party number information, the flag indicating a calling feature defined by a called party for use by the calling party one of a paging operation and a single number reach operation (see fig.9, [0041] to [0046] and [0048]).

As to claim 11, Albal discloses receiving a dialed number identification string (DNIS), and wherein the accessing step includes accessing a subscribers' profile based on the

DNIS, the subscriber's profile including the stored calling party number information and the corresponding personalized voice message (see [0050] to [0056] and [0069] to [0073]).

As to claim 12, Albal discloses a messaging system for playing a message of a called party (subscriber) to a calling party in response to a request for execution of a messaging operation, the request containing calling party number information, the messaging system including:

an application runtime environment configured for retrieving, for playback the messaging prompt as the messaging prompt to the calling party (see fig.2, abstract, (see [0025] to [0028]), a personalized, non generic voice message having a recorded voice of the called party (subscriber) (the subscriber can instruct the communication node to play a pre-record message or announcement or disconnect the call or indicating to the caller that the subscriber is unavailable, see [0031] to [0033]), based on a match of the received calling party number information with calling party number information stored in an Internet Protocol (IP) based database server (verifying the caller's number, see fig.4, [0029] to [0030]), the match identifying a matched calling party (finding a match between the caller's telephone number and a stored number in the subscriber's contact list, see [0025] to [0026]) the personalized voice message corresponding to the matched and stored calling number information of the calling party (automatically identifying the user and providing a personal greetings to the user, see [0040] and [0046] to [0050]).

Claims 13 and 15 are rejected for the same reasons set forth in claims 11 and 3 respectively.

Claims 18, 19, 22, 26-28 are rejected for the same reasons set forth in claims 1, 2, 5, 9-11 respectively.

Claims 29, 31 and 34 are rejected for the same reasons set forth in claims 12, 15 and 13 respectively.

As to claims 35-38, Albal discloses the personalized voice message contains information specifically for matched calling party (see [0022] to [0026]).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to



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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 4, 14, 20 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albal in view of Ng et al., US pat. No.6,243,376.

Albal's teachings still applied as in item 6 above. Albal does not specifically disclose using accessing message using LDAP protocol. However, LDAP protocol is generally well known in network standards art as disclosed by Ng (see abstract, col.7 lines 20-64). It would have obvious to one of the ordinary skill in the art at the time the invention was made to utilize LDAP protocol in the computer system of Albal to process calling information because it would have provided a standard way for Internet clients or applications and servers to access directories services and locate organizations, organization units or individuals (see Ng's col.7 lines 39-47).

7. Claims 3, 6-8, 16, 17, 21, 23-25, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albal and Ng as in item 7 above and further in view of Bobo, II, US pat. No.5,870,549.

Claims 3 and 6-8 are rejected for the same reasons set forth in item 7 above. Neither Albal nor Ng specifically discloses receiving an HTTP request from the calling party, generating an HTML page having XML tags and inserting a first media tag including a .wav file and a second media tag configured for controlling playing of the .wav file. However, Bobo discloses receiving an HTTP request from the calling party, generating an HTML page having XML tags and inserting a first media tag including a

.wav file and a second media tag configured for controlling playing of the .wav file (see abstract, figs. 1, 2, col. 7 line 28 to col. 8 line 46 and col. 13 line 13 to col. 14 line 55). It would have been obvious to one of the ordinary skill in the art at the time the invention was made to implement Bobo's teachings into the computer system of Albal for generating and executing web applications because it would have enabled users to deploy a scalable, open standards based form approval system on an open standards based Internet Protocol network using a telephone.

Claims 16 and 17 are rejected for the same reasons set forth in claims 7 and 8 respectively.

Claims 21, 23-25 are rejected for the same reasons set forth in claims 3, 6- 8 respectively.

Claims 32 and 33 are rejected for the same reasons set forth in claims 16 and 17 respectively.

#### **(10) Response to Argument**

A. Appellant asserts that claims 1-38 comply with the written description requirement under 35 U.S.C. 112, first paragraph since the term "personalized, non generic voice message" is described in the application's specification (page 11, lines 4-19).

*Examiner respectfully disagree. In the specification (page 11, lines 4-19), it describes only a generic message and a personalized message. There is no mention at all about the term "non generic voice message" as Appellant claimed. The term "non generic voice message" is not conventional or well known to one of the ordinary skill in the art at the invention was made. The claim(s) contains subject matter (the term "non generic voice message" in independent claims 1, 12, 18 and 29) which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Therefore, Examiner respectfully maintain the rejection of claims 1-38 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.*

B. Appellant asserts that the cited reference does not disclose based on a determined match of the stored calling party number information identifying the calling party as a matched calling party, retrieving a personalized, non generic voice message having a recorded voice of the called party, corresponding to the matched, stored calling party number information, for playback the message prompt to the calling party.

*Examiner respectfully disagree. Examiner respectfully point out that Albal discloses the Appellant's claimed invention. Albal discloses a method and*

*apparatus to delivery caller identification information to the calling user. Specifically, Abal discloses that based on a determined match of the stored calling party number information identifying the calling party as a matched calling party (finding a match between the caller's telephone number and a stored number in the subscriber's contact list, see [0025] to [0026]), retrieving a personalized, non generic voice message having a recorded voice of the called party (subscriber) (the subscriber can instruct the communication node to play a pre-record message or announcement or disconnect the call or indicating to the caller that the subscriber is unavailable, see [0031] to [0033]), corresponding to the matched, stored calling party number information, for playback the message prompt to the calling party (automatically identifying the calling user and providing a personal and recorded greeting specified only to the user after user's verification; for example, playing a greeting to the calling user (Bob) such as "this is your personal agent, Maya. Welcome Bob. How may I help you?", see [0040] and [0046] to [0050]). This is equivalent to what is claimed.*

C. Appellant asserts that the claims 4, 14, 20 and 30 depend from the independent claims and therefore are considered to be allowable for the reasons in B and for the reasons that the added subject matter is not taught or suggested by the prior art of record.

*Examiner respectfully point out that Abal discloses the independent claims as discussed in item B above. Furthermore, Examiner respectfully point out that the combination of Abal and Ng discloses the Appellant's invention. For example, Abal does not specifically disclose using accessing message using LDAP protocol. However, LDAP protocol is generally well known in network standards art as disclosed by Ng (see abstract, col.7 lines 20-64). It would have obvious to one of the ordinary skill in the art at the time the invention was made to utilize LDAP protocol in the computer system of Abal to process calling information because it would have provided a standard way for Internet clients or applications and servers to access directories services and locate organizations, organization units or individuals (see Ng's col.7 lines 39-47).*

D. Appellant asserts that the claims 3, 6-8, 17, 21, 23-25, 32 and 33 depend from the independent claims and therefore are considered to be allowable for the reasons in B.

*Examiner respectfully point out that Abal discloses the independent claims as discussed in item B above. Furthermore, Examiner respectfully point out that the combination of Abal and Ng and further in view of Bobo discloses the Appellant's invention. For example, neither Abal nor Ng specifically discloses receiving an HTTP*

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*request from the calling party, generating an HTML page having XML tags and inserting a first media tag including a .wav file and a second media tag configured for controlling playing of the .wav file. However, Bobo discloses receiving an HTTP request from the calling party, generating an HTML page having XML tags and inserting a first media tag including a .wav file and a second media tag configured for controlling playing of the .wav file (see abstract, figs. 1, 2, col. 7 line 28 to col. 8 line 46 and col. 13 line 13 to col. 14 line 55). It would have been obvious to one of the ordinary skill in the art at the time the invention was made to implement Bobo's teachings into the computer system of Albal for generating and executing web applications because it would have enabled users to deploy a scalable, open standards based form approval system on an open standards based Internet Protocol network using a telephone.*

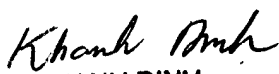
**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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